

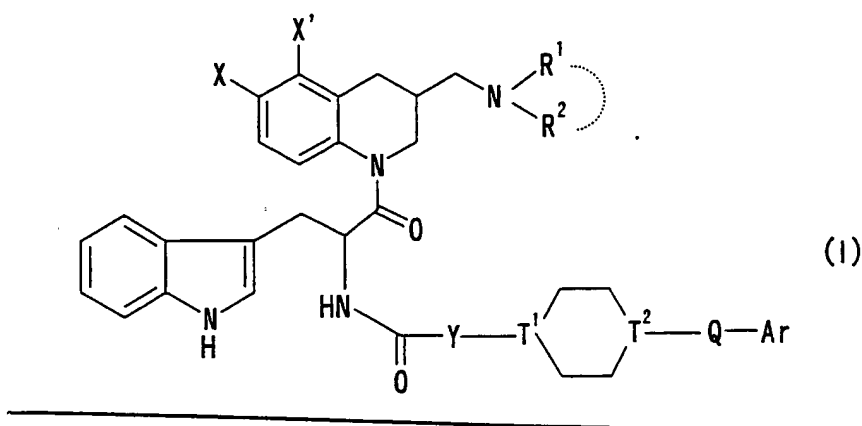
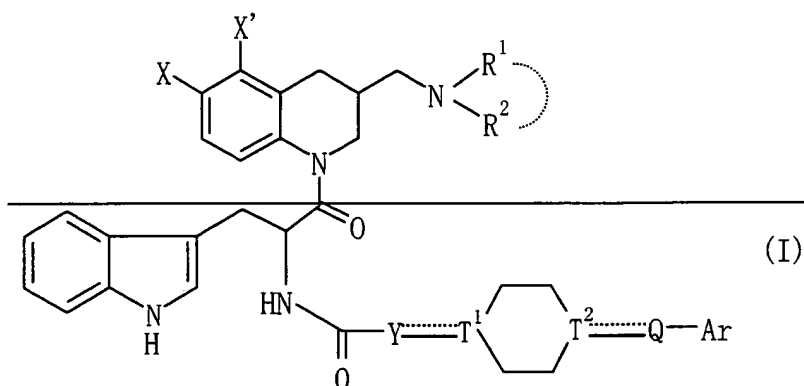
**In the Claims**

**Please substitute the following claims 1, 3, 14, 19 and 28 for the claims 1, 3, 14, 19 and 28 now pending in the above-identified application.**

**Please cancel claims 2, 4, 7, 10, 12, 15, 16, 21-24 and 29-35.**

**Please add new claims 39-44.**

1. (Currently Amended) A compound of the formula:



wherein X and X' are the same or different, and each represents a hydrogen atom, a fluorine ~~atom, atom or~~ a chlorine atom ~~or an amino optionally having substituents~~, and at least one of X and X' represents a fluorine ~~atom, atom or~~ a chlorine atom ~~or an amino optionally having substituents~~;

R<sup>1</sup> and R<sup>2</sup> represent a hydrogen atom or C<sub>1-6</sub> alkyl optionally having substituents, or R<sup>1</sup> and R<sup>2</sup>, together with the adjacent nitrogen atom, form a nitrogen-containing heterocyclic ring optionally having substituents;

Y and Q are the same or different, and each represents a bond or a spacer having a main

chain of 1 to 6 atoms;

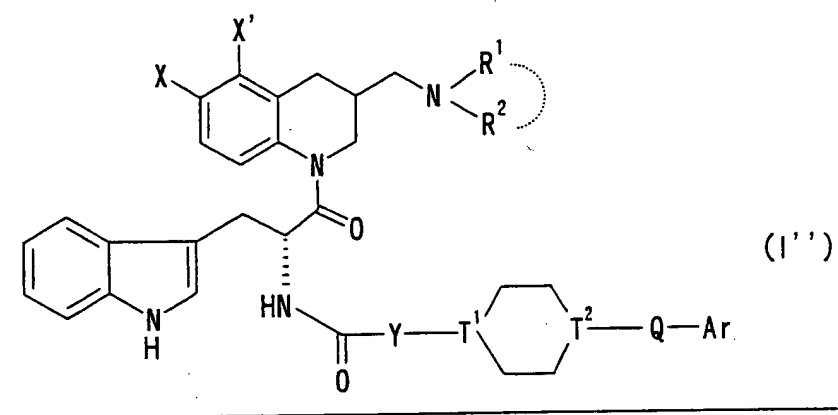
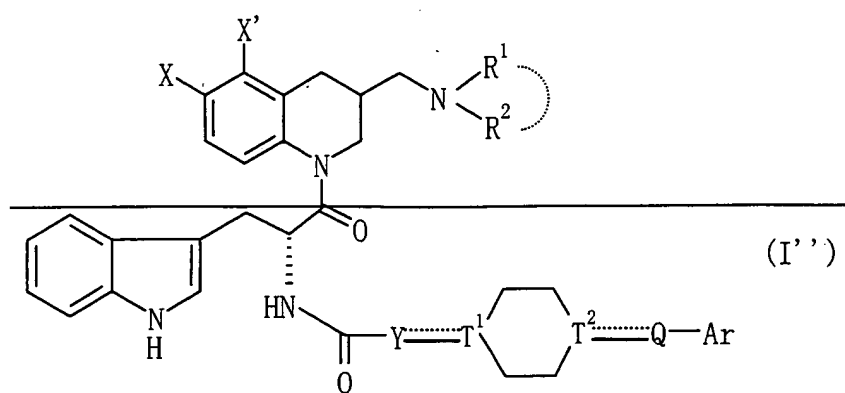
~~... represents a single bond or a double bond;~~

T<sup>1</sup> and T<sup>2</sup> are the same or different, and each represents CH C(R<sup>9</sup>) (~~R<sup>9</sup> represents a hydrogen atom, a hydroxy or C<sub>1-6</sub> alkyl~~) or N N, ~~when each of the adjacent ... is a single bond, and C when the adjacent ... is a double bond;~~ and

Ar represents an aromatic group optionally having substituents ~~substituents, a C<sub>3-9</sub> cycloalkyl group optionally having substituents, a 3 to 9 membered saturated heterocyclic group optionally having substituents, a hydrogen atom or a halogen atom;~~ provided that 6-chloro-3-(R,S)-(N,N-dimethylamino)methyl-1-[3-(indol-3-yl)-2-[(R)-(4-phenylpiperazin-1-yl)carbonylamino]propanoyl]-1,2,3,4-tetrahydroquinoline; 6-chloro-3-(R,S)-(N,N-dimethylamino)methyl-1-[3-(indol-3-yl)-2-[(R)-4-(2-oxo-2,3-dihydro-1H-benzimidazol-1-yl)piperidinocarbonylamino]propanoyl]-1,2,3,4-tetrahydroquinoline and 1-benzoyl-N-[(R)-2-[6-chloro-3-[(N,N-dimethylamino)methyl]-1,2,3,4-tetrahydroquinolin-1-yl]-1-[3-(indol-3-yl)propanoyl]-4-piperidinecarboxamide are excluded; or a salt thereof.

Claim 2 (Cancelled).

3. (Currently Amended) The compound according to claim 1, wherein compound (I) is represented by the formula:



wherein each symbol has the same meaning as in claim 1.

Claim 4 (Cancelled).

5. (Previously Presented) The compound according to claim 1 wherein X is a fluorine atom or a chlorine atom and X' is a hydrogen atom.

6. (Previously Presented) The compound according to claim 1 wherein X is a chlorine atom and X' is a hydrogen atom.

Claim 7 (Cancelled).

8. (Previously Presented) The compound according to claim 1 wherein R<sup>1</sup> and R<sup>2</sup> are each C<sub>1-6</sub> alkyl.

9. (Original) The compound according to claim 1, wherein the spacer having a main chain of 1 to 6 atoms represented by Y and Q is a divalent group comprising of 1 to 3 groups selected from -O-, -S-, -CO-, -SO-, -SO<sub>2</sub>-, -NR<sup>8</sup>- (R<sup>8</sup> is a hydrogen atom, an optionally halogenated C<sub>1-6</sub> alkyl, an optionally halogenated C<sub>1-6</sub> alkyl-carbonyl, an optionally halogenated C<sub>1-6</sub> alkylsulfonyl) and an optionally halogenated divalent C<sub>1-6</sub> non-cyclic hydrocarbon group.

Claim 10 (Cancelled).

11. (Previously Presented) The compound according to claim 1 wherein Y is a bond or C<sub>1-2</sub> alkylene.

Claim 12 (Cancelled).

13. (Previously Presented) The compound according to claim 1 wherein Q is -CO-.

14. (Currently Amended) The compound according to claim 1 ~~wherein Y represents a single~~

~~bond~~, wherein T<sup>1</sup> is CH and T<sup>2</sup> is N.

Claims 15 and 16 (Cancelled).

17. (Previously Presented) The compound according to claim 1 wherein Ar is a monocyclic aromatic group optionally having substituents.

18. (Previously Presented) The compound according to claim 1 wherein Ar is a fused aromatic group optionally having substituents.

19. (Currently Amended) The compound according to claim 17, wherein Ar is phenyl which may have 1 or 2 substituents selected from a halogen atom, ~~a cyano~~, an optionally halogenated C<sub>1-6</sub> alkyl and an optionally halogenated C<sub>1-6</sub> alkoxy.

20. (Original) The compound according to claim 18, wherein Ar is indol-2-yl which may have 1 or 2 substituents selected from a halogen atom, an optionally halogenated C<sub>1-6</sub> alkyl and an optionally halogenated C<sub>1-6</sub> alkoxy.

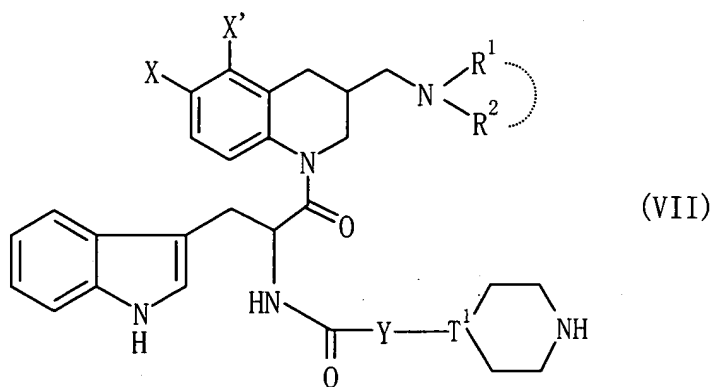
Claims 21-27 (Cancelled).

Claims 29-35 (Cancelled).

36. (Previously Presented) A method for inhibiting somatostatin receptor binding, which comprises administering to a mammal an effective amount of the compound according to claim 1, a salt thereof or a prodrug thereof.

**Claim 37. (Cancelled)**

38. (Original) A compound of the formula:



wherein each symbol has the same meaning as in claim 1, or a salt thereof.

39. (New) The method according to claim 36, wherein the somatostatin receptor is a somatostatin subtype 2 receptor.

40. (New) A method for agonizing somatostatin receptor, which comprises administering to

a mammal an effective amount of the compound according to claim 1, a salt thereof or a prodrug thereof.

41. (New) The method according to claim 40, wherein the somatostatin receptor is a somatostatin subtype 2 receptor.

42. (New) A method for treating diabetes or diabetic nephropathy, which comprises administering to a mammal an effective amount of the compound according to claim 1, a salt thereof or a prodrug thereof.

43. (New) A method for treating tumors selected from the group consisting of acromegaly, TSH-producing tumors, nonsecretory (afunctional) hypophysial tumors, ectopic ACTH (adrenocorticotrophic hormone) –producing tumors, medullar thyroid carcinoma, VIP-producing tumors, glucagon-producing tumors, gastrin-producing tumors, insulinoma and carotinoid, which comprises administering to a mammal an effective amount of the compound according to claim 1, a salt thereof or a prodrug thereof.

44. (New) A method for treating diarrhea due to neuroendocrine tumors or diarrhea due to AIDS, which comprises administering to a mammal an effective amount of the compound according to claim 1, a salt thereof or a prodrug thereof.



## **I. Amendments**

By this amendment, claims 1, 3, 14, 19 and 28 have been amended, claims 2, 4, 7, 10, 12, 15, 16, 21-24 and 29-35 have been cancelled and new claims 39-44 have been added.

Claim 28 has been amended to add carriers, in accordance with the teachings of the specification at page 82, line 15 – page 84, line 2 *inter alia*.

No change of inventorship is necessitated by this amendment.

## **II. Discussion of the Previously Filed Preliminary Amendment**

A Preliminary Amendment was filed on April 4, 2002. The Notice of Missing Requirements dated August 28, 2002 acknowledged receipt of the Preliminary Amendment. In the Preliminary Amendment, claims 25-27 and 37 were cancelled and claims 4-8, 10-18, 28 and 36 were amended. Since the amendment modified the claims, Applicants respectfully request its consideration and entry into the record. Should the Preliminary Amendment not be in the Examiner's files, the Examiner is requested to contact Applicants' attorney for a copy.

## **III. Discussion of the New Claims**

New claims 39-44 have been added by this amendment. These new claims add no new matter to the specification. Support for the new claims may be found in originally filed claims 30-35 *inter alia*.

## **IV. Discussion of the Objection to the Abstract**

The Abstract has been objected to because of its length. By this amendment, the Abstract has been shortened. Therefore Applicants respectfully request withdrawal of the objection to the Abstract.

**V. Discussion of the 35 U.S.C. Sec. 112, First Paragraph Rejection of Claim 34**

Claim 34 has been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly non-enabled. Applicants respectfully traverse this rejection.

By this amendment, claim 34 has been cancelled, thereby rendering the rejection moot. However, Applicants have added new claim 43 which describes a method for treating certain tumors. Applicants believe that new claim 43 is adequately enabled.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claim 34.

**VI. Discussion of the 35 U.S.C. Sec. 112, First Paragraph Rejection of Claims 25, 36 and 37**

Claims 25, 36 and 37 have been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly lacking enablement in the recitation of “prodrug”.

As indicated in Sec. II above, claims 25 and 37 are no longer pending, as they were previously cancelled by the Preliminary Amendment.

As to claim 36, Applicants assert that the term “prodrug” is adequately enabled by the specification. Applicants would like to draw the Examiner’s attention to page 53, line 3 – page 54, line 13 of the specification, wherein prodrugs are described.

In addition, the term is found in claim 28, as well as in new claims 40-44. Applicants believe that these claims are adequately enabled by the teachings of the specification as well.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, first paragraph rejection of claims 25, 36 and 37.

## VII. Discussion of the 35 U.S.C. Sec. 112, Second Paragraph Rejection

Claims 1-4, 29-35 and 37 have been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly being indefinite. Applicants respectfully traverse this rejection. Each aspect of the rejection will be discussed separately in the following paragraphs.

As to the first aspect of the rejection, by this amendment claims 29-35 have been cancelled so Applicants assert that this aspect of the rejection is moot.

As to the second aspect of the rejection, the Examiner has objected to the use of the term “spacer” in claim 1. Applicants disagree that the term either that is vague or that the metes and bounds of the term are unknown. Applicants would like to draw the Examiner’s attention to the specification at page 26, lines 11-23 wherein the spacer is defined.

As to the third aspect of the rejection, the Examiner has objected to the phrase “optionally having substituents” in claims 1-4. By this amendment, claims 2 and 4 have been cancelled. However, Applicants assert that the use of the phrase “optionally having substituents” in claim 1 does not render claim 1 or its dependent claims vague. This is so because the specification defines the identity for the optional substituents of each of the variables in formula (I). The Examiner is respectfully requested to consider the following portions of the specification, wherein definitions may be found:

For  $R^1$  and  $R^2$ , “ $C_{1-6}$  alkyl optionally having substituents” is defined on page 19, line 18 – page 20, line 19; and “heterocyclic ring optionally having substituents” is defined on page 22, line 28- page 23, line 6.

For Ar, “aromatic group optionally having substituents” is defined on page 32, line 25 – page 33, line 15; “ $C_{3-9}$  cycloalkyl group optionally having substituents” is defined on page 43, line 26 – page 44, line 6; and “heterocyclic group optionally having substituents” is defined on page 45, lines 12-20.

Therefore, Applicants assert that the phrase “optionally having substituents” is sufficiently clear.

As to the fourth aspect of the rejection, by this amendment claim 34 has been cancelled. Applicants assert that this aspect of the rejection is moot.

As to the fifth aspect of the rejection, as stated in Sec. II above, claim 37 is not pending, so Applicants believe that this aspect of the rejection is moot

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 112, second paragraph rejection.

#### **VIII. Discussion of the 35 U.S.C. Sec. 101 Rejection of Claim 37**

Claim 37 has been rejected under 35 U.S.C. Sec. 101 as allegedly being an improper use claim.

As stated in Sec. II above, claim 37 is not pending, so Applicants believe that this rejection is moot.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 101 rejection.

#### **IX. Discussion of the Rejection under 35 U.S.C. Sec. 102(a) over Suzuki *et al.***

Claims 1-11, 14-23 and 25-37 have been rejected under 35 U.S.C. Sec. 102(a) as allegedly being anticipated by Suzuki *et al.*, Chem. Abstracts 131: 286420 (WO 99/52875). Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claims 25-27 and 37 were cancelled by the Preliminary Amendment and that claims 2, 4, 7, 10, 15, 16, 21-23 and 29-35 have been cancelled by the present amendment.

A Certified Copy of the English language Translation of the priority Japanese application accompanies this response. In addition, the pending claims have been limited to the invention as recited in the priority Japanese application. Therefore, Applicants have perfected their claim for priority, and respectfully assert that the cited reference is not proper art.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 102(a) rejection.

**X. Discussion of the 35 U.S.C. Sec. 103(a) Rejection over Suzuki *et al.***

Claims 1-38 have been rejected under 35 U.S.C. Sec. 103(a) as allegedly being unpatentable over Suzuki *et al.* (WO 99/52875). Applicants respectfully traverse the rejection.

As an initial matter, Applicants note that claims 25-27 and 37 were cancelled by the Preliminary Amendment and that claims 2, 4, 7, 10, 15, 16, 21-23 and 29-35 have been cancelled by the present amendment.

A Certified Copy of the English language Translation of the priority Japanese application accompanies this response. In addition, the pending claims have been limited to the invention as recited in the priority Japanese application. Therefore, Applicants have perfected their claim for priority, and respectfully assert that the cited reference is not proper art.

Therefore Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 103(a) rejection over Suzuki *et al.*

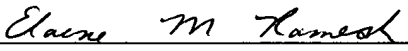
**XI. Conclusion**

Reconsideration of the claims as amended and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully invited to call Applicants' attorney at the number below.

Respectfully submitted,

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